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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/622,629

10/20/2000

David A. Mark

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03/28/2003

BELL, BOYD & LLOYD LLC  
P. O. BOX 1135  
CHICAGO, IL 60690-1135

EXAMINER

SHARAREH, SHAHNAM J

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/622,629

Applicant(s)

MARK ET AL.

Examiner

Shahnam Sharareh

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1 and 3-15.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: PTO-892

RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments are in view of the amended claims after final and thus not commensurate with the scope of the rejected claims. Further, they do not seem to overcome the rejections of record. With respect to applicants' arguments directed to Schmidl, Applicant states that Schmidl fails to disclose or suggest caloric density of about 1.5 Kcal/ml. In response Examiner states that the rejected claims recite caloric density of 1.4Kcal/ml. Accordingly, Examiner relying on the nitrogen ration taught by Schmidl's formulation, its osmolality and the use of whey hydrolysate, a lipid and a carbohydrate source concluded that Schmidl's formulation inherently meets such characteristics because it comprises all essential elements of the instant broadest claims. No evidence are provided to show otherwise. Further, Applicant's reliance on *Scaltech, Inc V. Retec*, 51 USPQ 2d 1055, is misplaced. Contrary to Applicant's arguments the rejection over Schmidl is not based on mere possibilities or probabilities, rather natural result flowing from operation of the elements disclosed by Schmidl. Applicant appears to be arguing that the rejection is based on the presence of a protein source, a lipid source and a carbohydrate source. Applicant fails to substantiate other teachings of Schmidl, namely its osmolality, the nature of its protein source, the amounts of the protein source, the amounts of carbohydrates and lipids. All such teachings of Schmidl falls within the instantly taught claims. The osmolality of Schmidl falls within the instantly taught Osmolality (see spec page 7, line 30-33). Schmidl teaches the use of whey hydrolysate in amounts of 16-25%. The lipid source used in Schmidl falls within the same range as instantly claimed. The carbohydrate of Schmidl is within the same range as those instantly taught (see spec, page 5, line 1). Therefore, as reasoned in *Continental*, 11 USPQ2d 1264, 1766(Fed Cir 1991). The disclosure of Schmidl is sufficient to show that the natural result flowing from its operation would result in the such products that encompass the questioned caloric density. No specific limitation in the instant claims exclude the products of Schmidl. Thus, the rejection is maintained. Applicant's arguments with respect to Henningfield have been considered but are not found persuasive. Henningfield discloses partially Lactalbumins that are known in the art as whey proteins or at least are considered a species of whey protein (see Henningfield col 10, line 31-34 or the attached article para. 3, by Ben Best). Contrary to Applicants assertion, Henningfield teach protein density of at least about 18-24% (col 9, line28). Further it discloses hydrolyzed lactalbumin in amounts of 20% which is considered to encompass "about 18%." (Id.). Further, the intended use does not impart patentability of product claims. The instant claims are not limited to whey proteins as the sole protein source of the formulation, thus, Henningfields products encompass the instantly claimed compositions. Applicants arguments with respect to the rejection of Gray in view of Schmidl are also considered but are not found persuasive for similar reasons of record. ...